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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,004	02/21/2006	Rolf Thiel	25687103898	1761
28886	7590	06/20/2007		
CLARK HILL, P.C. 500 WOODWARD AVENUE, SUITE 3500 DETROIT, MI 48226			EXAMINER NGUYEN, THONG Q	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/569,004	<b>Applicant(s)</b> THIEL ET AL.	
	<b>Examiner</b> Thong Q. Nguyen	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21 is/are rejected.
- 7) ☒ Claim(s) 14-20, 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Pre-Amendment***

1. The present Office action is made in response to the Pre-amendment filed on 2/21/2006. It is noted that in the Pre-amendment, applicant has made changes to the abstract, the specification and the claims. Applicant has also provided a substitute specification and a marked-up copy showing the changes to the specification.

Regarding to the claims, applicant has canceled all original claims 1-13 and added a new set of claims, i.e., claims 14-24, into the application.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)),

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and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

#### ***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not include the inventors' signatures or the inventors' signatures are in the wrong places.

#### ***Drawings***

5. The drawings contained four sheets of figures 1-4, 5a-c and 6-7 were received on 2/21/06. These drawings are objected by the examiner for the following reason(s).

6. The drawings are objected to because the orientation of the light guide 8' as shown in each of figures 2-4 is improper. Applicant should note that the specification, in section [0013] has stated that the entrance surface (16) of the light guide (8') faces towards the front side while the entrance surface (15) of the light guide (8) faces towards the rear side. However, in each of figures 2-4 both the entrance surfaces (15, 16) of the light guides (8 and 8') face towards the rear side. Applicant should amend the figures 2-4 to show that the entrance surface of the light guide (8') faces towards the

front side. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Each of the references "2a" and "2b" as stated in section [0012]; the reference "8b" as stated in section [0013]; and the reference "30" as stated in section [023] is not shown in at least one figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being

amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features recited in the claims but not shown in the drawings; First, the feature related to the structure among the light guide, the housing and the sensor as recited in the feature thereof "a light guide disposed between said housing and said sensor" recited in claim 14, line 8; Second, the feature related to the structure among the first light entrance surface of the first light guide channel and the electrochromic mirror glass as recited in the feature thereof "said first light guide...mirror glass" recited in claim 16, lines 1-3; Third, the feature related to the structure among the second light entrance surface of the second light guide channel and the electrochromic mirror glass as recited in the feature thereof "said second light guide...mirror glass" recited in claim 17, lines 1-3; and Fourth, the feature related to the arrangement of the switching device adjacent the combined light guide portion as recited in the feature thereof "said switching...said sensor" recited in claim 21, lines 1-3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

9. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

10. The disclosure is objected to because of the following informalities: a) page 1: section [0001], line 1 of the section, the sentence thereof "the invention related to a rearview mirror for vehicles" has a grammatical error. In other words, how can a plurality of vehicles have a single rearview mirror. See also the correct use of language as provided in the sentence thereof "More particularly, the invention related to rearview

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mirrors for motor vehicles...bright lights” on lines 2-3 of the same section; b) Page 6: section [0027], line 2 of the section, “Figure 5” should be changed to --Figure 5a--; c) page 6: section [0029], line 1 of the section, “Fig. 5” should be changed to --Fig. 5c--. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

11. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification has not positively provided a proper antecedent basis for the following features.

First, the feature related to the structure among the first light entrance surface of the first light guide channel and the electrochromic mirror glass as recited in the feature thereof “said first light guide...mirror glass” recited in claim 16, lines 1-3; and

Second, the feature related to the structure among the second light entrance surface of the second light guide channel and the electrochromic mirror glass as recited in the feature thereof “said second light guide...mirror glass” recited in claim 17, lines 1-3.

### ***Claim Objections***

12. Claims 14-24 are objected to because of the following informalities. Appropriate correction is required.

a) In claim 14: on lines 10-11, the feature thereof “a switching device for periodically disrupting the transmission of light to identify a presence of the glare



light” is unclear because it is unclear which light applicant imply by “the light” (line 10). Applicant should note that the claim recites two kinds of light, i.e., an ambient light and a glare light, as can be seen on lines 6-7.

The examiner is of opinion that the terms “the light” appeared on line 10 of the claim should be changed to --the ambient light--. The support for that suggestion is found in the specification in sections [0013]-[0018] and also in the claim 14 itself when the claim recites that the switching device is operated to identify the presence of the glare light.

b) The remaining claims are dependent upon the objected base claim and thus inherit the deficiency thereof.

### ***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 21 is rejected under 35 USC 112, first paragraph because the disclosure, as originally filed, does not provide support for the arrangement of a switching device, a light guide and a sensor as recited in the claim. In particular, the

specification does not disclose that the switching device is disposed adjacent the combined light guide portion to periodically interrupt light from entering the sensor. Applicant is respectfully invited to review the specification, in particular, the embodiment described in sections [0013]-[0014] and shown in fig. 2. In this embodiment, the light guide (8 and 8') merges into an area (8b) in front of the sensor (7). A switching device 920) having an optical switch (9) is disposed in front of the entrance surface (16) of the light guide section(8') to periodically interrupt ambient light from entering the sensor. It is noted that while the optical switch (9) of the switching device (20) is disposed between the emission surface of the light guide (8') and the sensor (7) is disclosed in sections [0016]-[0017] and shown in figs. 3-4; however, in the embodiments described in sections [0016]-[0017] and shown in figs. 3-4, the light guide is NOT merged into a combined light guide portion.

It is also noted that the optical switch (9) CANNOT disposed between both the emission surfaces of the light guide (8 and 8') and the sensor because if it is disposed at that position, it will interrupt both glare light and ambient light to the sensor and thus is not disclosed/taught by the inventive device.

### ***Double Patenting***

15. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to

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identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

16. Claim 22 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 19. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

It is also suggested that in case the applicant makes a cancellation of claim 22 then applicant should amend each of claims 23 and 24 for the purpose of providing a proper dependent status of those claims.

#### ***Allowable Subject Matter***

17. Claims 14-20 and 23-24 would be allowable if rewritten or amended to overcome the objection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

18. The following is a statement of reasons for the indication of allowable subject matter:

The rearview mirror as recited in the independent claim 14 is patentable with respect to the prior art, in particular, the Pub. Nos. 2003/0043589 and 2002/0171954; the U.S. Patent Nos. 5,148,014 and 6,359,274 and the EP 705 734 by the limitations related to the sensor having light guide disposed between a housing and the sensor for guiding ambient light and glare light outside the housing to the sensor and a switching device for periodically disrupting the transmission of ambient light to identify a presence of the glare light so that the sensor creates a dimming signal upon the identification of the presence of the glare light to dim the electrochromic mirror. It is noted that a) the use of a sensor having light guide disposed between a housing and the sensor for guiding ambient light and glare light outside the housing to the sensor is disclosed in the Pub. No. 2003/0043589; 2) the use of a filter in front of an ambient sensor for attenuating the light is disclosed in the mentioned EP reference, or after an ambient sensor for attenuating the ambient light level signal is disclosed in the Pub. No. 2002/0171954; and 3) a switching system for controlling the reflectance of an mirror based on the signals from an ambient and a glare sensors is disclosed in the U.S. Patent Nos. 5,148,014 and 6,359,274; however, the cited art by itself or in combination does not disclose the sensor with the features related to the switching device as recited in the independent claim 14, lines 10-12.

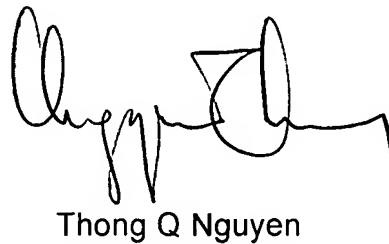
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***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Thong Q. Nguyen', with a stylized, elongated flourish extending to the right.

Thong Q Nguyen  
Primary Examiner  
Art Unit 2872

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